Exhibit 4

NO FEE

I, PURITA T. EUGENIO, hereby certify that this document is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to BOX TTAB NO FEE, ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513
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Date of Deposit:: APRIL 26, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MARK D. TANNEN,

Opposer,

vs.

JAY MACK,

Applicant.

Opposition No.: 91151109
Serial No.: 75/845,350

MEMORANDUM OF LAW IN SUPPORT OF APPLICANT'S MOTION TO DISMISS OPPOSITION FOR LACK OF SUBJECT MATTER JURISDICTION, OR IN THE ALTERNATIVE FOR SUMMARY JUDGMENT (FRCP 12(B)(1), FRCP 56(C)

I. INTRODUCTION:

On December 1, 1999, Applicant filed its intent-to-use application for registration of the mark INTELLIWEAR in International Class 9 for "wearable computer hardware and computer software, namely, wearable micro processor-powered computers and associated software used for hands free data entry, data storage, data retrieval and data processing, and used for electronic messaging and for connecting to the internet." It was assigned Serial No. 75/845,350. The mark was

published in the *Official Gazette* of the United States Patent and Trademark Office on October 30, 2001.

On February 27, 2002, Opposer filed a Notice of Opposition alleging that the "goods to which Applicant's alleged INTELLIWEAR mark will be applied and the goods/services upon which Opposer's AMERICAN INTELLIWARE and AI AMERICAN INTELLIWARE AND DESIGN ("AMERICAN INTELLIWARE Marks") are extensively used and/or registered are or are likely to be related" and that the "Applicant's alleged INTELLIWEAR mark is confusingly similar to the AMERICAN INTELLIWARE Marks owned by Opposer; it falsely suggests a connection with Opposer; it constitute a false representation that Applicant's goods are approved or sponsored of Opposer or that Applicant's business is connected or affiliated with Opposer or that INTELLIWEAR is a version of Opposer's AMERICAN INTELLIWARE Marks, and its use and registration contemporaneously with Opposer's AMERICAN INTELLIWARE Marks is likely to cause consumer confusion, mistake and deception as to the source of Applicant's goods," (Notice of Opposition §§ 8-9).

Further, in his Notice of Opposition, Opposer claimed that "through his predecessors in interest, has been engaged for over (16) sixteen year in the development, marketing and sale of desktop and portable computer hardware . . .", that Opposer had used his mark AI AMERICAN INTELLIWARE since at least June 15, 1984, that Opposer has long been using his marks extensively and continuously, that he "is also the owner of valid and subsisting U. S. Registration No. 1,347,429 for the mark AI AMERICAN INTELLIWARE and Design," and that because of this, "Opposer had priority over Applicant because its use and/or registration date for the AMERICAN

INTELLIWARE Marks precede the Applicant's filing date for its intent-to-use application. (Notice of Opposition §§1-7).

The fundamental issues in this Motion are as follows:

(1) In the issue of Motion for Dismissal: Opposer is not a real party in interest to the mark AI AMERICAN INTELLIWARE, and thus Opposer has no standing to oppose registration of the Applicant's mark INTELLIWEAR, and

(2) In the issue of Motion for Summary Judgment: As demonstrated below, TANNEN's opposition is baseless. The undisputed facts establish that there is no genuine issue for trial and that Applicant is entitled to judgment as a matter of law.

II. ARGUMENTS IN THE CASE OF MOTION TO DISMISS

A. LACK OF SUBJECT MATTER JURISDICTION DUE TO LACK OF STANDING

1. Opposer's Notice of Opposition Should Be Dismissed Pursuant to Rule 12(b)(1) Because the Opposer Lacks Standing

A Rule 12(b)(1) motion to dismiss for lack of standing may attack the court's subject matter jurisdiction either facially or factually. *See White v. Lee*, 227 F.3d 1214, 1242 (9th Cir. 2000) (stating that standing pertains to a federal court's subject matter jurisdiction). An Opposer has the burden of establishing standing. *See Thompson v. McCombe*, 99 F.3d 352, 353 (9th Cir. 1996) ("A party invoking the federal court's jurisdiction has the burden of proving the actual existence of subject matter jurisdiction").

In this case, the Opposer has alleged that he is a real party in interest based on his rights acquired by the assignment of a federally registered trademark. When, as here, a Rule 12(b)(1) attack is factual, the court may look beyond the complaint to matters of public record without having

to convert the motion into one for summary judgment. *See White*, 227 F.3d at 1242. The court also need not presume the truthfulness of a plaintiff's allegations. *Id.* Because the records of the U.S. Patent and Trademark Office ("USPTO") and the Secretary of State of California show that he is not the owner of the trademark claimed, the opposer cannot object to this evidence to survive a motion to dismiss.

Because standing is determined at the time the Opposition is filed, post opposition actions on the part of the Opposer offer no relief. *See Becker v. Federal Election Comm'n*, 230 F.3d 381, 386 n.3 (1st Cir. 2000); *White v. Lee*, 227 F.3d 1214, 1243 (9th Cir. 2000); *Park v. Forest Serv. of the United States*, 205 F.3d 1034, 1037 (8th Cir. 2000); *Perry v. Village of Arlington Heights*, 186 F.3d 826, 831 (7th Cir. 1999); *Carr v. Alta Verde Indus., Inc.*, 931 F.2d 1055, 1061 (5th Cir. 1991). In addition to these constitutional requirements, in a challenge to administrative action, a plaintiff must establish prudential standing. *See Valley Forge Christian Coll. v. Americans United for Separation of Church & State, Inc.*, 454 U.S. 464, 474-75, 70 L. Ed. 2d 700, 102 S. Ct. 752 (1982); *Presidio Golf Club v. National Park Serv.*, 155 F.3d 1153, 1157 (9th Cir. 1998).

2. Opposer Does Not Possess The "AI AMERICAN INTELLIWARE AND DESIGN" Mark

Opposer claims rights "through his predecessors in interest" using the marks AMERICAN INTELLIWARE, AI AMERICAN INTELLIWARE AND DESIGN and variants thereof since as early as June 15, 1984. (Notice of Opposition §§1-3) Opposer further claims that he is the owner of U. S. Registration No. 1,347,429 for the mark AI AMERICAN INTELLIWARE and Design. (Notice of Opposition §5) The USPTO records for this mark clearly indicate the applicant and original owner as American Intelliware Corporation, a California Corporation. The USPTO records for this mark also show an assignment of the mark from American Intelliware

Corporation to Mark D. Tannen dated June 30, 1995. The assignor's signatory is listed as Mark D. Tannen, President of American Intelliware Corporation. A copy of this trademark assignment is attached herewith as **Exhibit A** and incorporated by reference.

A check of the corporate status of American Intelliware Corporation with the California Secretary of State revealed that on June 1, 1994, pursuant to the provisions of the California Bank and Corporation Tax Law, that the exercise of corporate powers, rights and privileges of the American Intelliware Corporation had been suspended. A certified copy of the Domestic Corporation Certificate of Filing and Suspension of American Intelliware Corporation as of December 19, 2001 is attached hereto as **Exhibit B** and incorporated by reference.

> Under California law, a corporation, which has been suspended for failure to pay franchise taxes, is prohibited from conveying property or enforcing a contract. *Usher v. Henkel*, 205 Cal. 413, 417, 271 P. 494 (1928); *Damato v. Slevin*, 214 Cal.App.3d 668, 674, 262 Cal. Rptr. 879 (1989); We have stated that upon suspension of a corporate franchise, the business entity "[can] not function as a corporation and [is] incapable of exercising corporate powers for any business purpose." *Lloyd Myers Co. v. Department of Agric.*, 1994 U.S. App. LEXIS 1923 (9th Cir. Jan. 26, 1994) *citing McLaughlin Land & Livestock Co. v. Bank of America*, 94 F.2d 491, 493 (9th Cir. 1938).

As a result of American Intelliware Corporation's corporate status being suspended on June 1, 1994, there existed no corporate authority to transfer the mark AI AMERICAN INTELLIWARE AND DESIGN to the Opposer or anyone else. Therefore, the assignment of the mark from Opposer (as president of a defunct corporation) to himself as an individual is void because of the lack of corporate authority to assign the mark. Opposer is therefore not the owner of the mark as alleged in his Notice of Opposition, and has no standing to oppose the Applicant's registration of the mark INTELLIWEAR on this basis.

B. IN THE ALTERNATIVE, SUMMARY JUDGMENT IS APPROPRIATE AND SHOULD BE GRANTED IN APPLICANT'S FAVOR

Resolution of inter partes proceeding by means of summary judgment is encouraged by the Courts. "The practice of the U.S. Claims Court ... in routinely disposing of numerous cases on the basis of cross-motions for summary judgment has much to commend it. The adoption of similar practice is to be encouraged in inter partes cases before the Trademark Trial and Appeal Board, which seem particularly suitable to this type of disposition." *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 627, 222 USPQ 741 (Fed. Cir. 1984) Applicant believes that Opposer's opposition should be dismissed for lack of standing based on the above facts presented that Opposer is not a real party in interest and has not properly established the existence of a case or controversy between himself and the Applicant and the reasons outlined below.

III. ARGUMENTS IN THE CASE OF MOTION FOR SUMMARY JUDGMENT

A. STANDARD OF REVIEW

A party is entitled to summary judgment where "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); TBMP §528. "An issue is material when its resolution would affect the outcome of the proceeding under governing law." *Institut National Des Appellations D'Origine and the Bureau National Interprofessional du Cognac v. Brown-Forman Corp.*, 1998 WL 285158 (TTAB 1998) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The initial burden is on the movant to prove that there is no genuine issue of material fact. *See Perma Ceram Enters., Inc. v. Preco Indus. Ltd., d/b/a Fosroc-Preco*, 23 USPQ2d 1134 (TTAB 1992) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986)). "[T]he burden on the moving party is discharged by 'showing' . . .

that there is an absence of evidence to support the nonmoving party's case." *Mirage Resorts, Inc. v. Solo Cup Co.*, 1995 WL 237193, *2 (TTAB 1995) (citing *Celotex Corp.*, 477 U.S. at 325).

"[A]s a general rule, the resolution of Board proceedings by means of summary is to be encouraged." *University Book Store, Brown's Book Shop and the Wisconsin Merchant's Fed'n v. Board of Regents of the Univ. of Wisconsin Sys.*, 33 USPQ2d 1385 (TTAB 1994) (citing *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560 (Fed. Cir. 1987)). Where, as here, there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result, summary judgment should be granted in the interests of judicial economy. *See Mattel, Inc. v. Cindy Bunin Nuyrick*, 1997 TTAB LEXIS 148, *2 (TTAB 1997) (citing *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984)).

Likelihood of confusion is a question of law. *See Sweats Fashions, Inc.*, 833 F.2d at 1565. Summary judgment therefore is appropriate in the context of an opposition based on likelihood of confusion. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 332-33, 21 USPQ2d 142 (Fed. Cir. 1991) (dissimilarity between competing marks "fully supports" entry of summary judgment dismissing an opposition); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 1388, 9 USPQ2d 1736 (Fed. Cir. 1989) (affirming grant of summary judgment dismissing opposition based on likelihood of confusion); *Pure Golds, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984) (affirming grant of summary judgment dismissing opposition based on likelihood of confusion).

B. ARGUMENTS

TANNEN based his opposition on an alleged likelihood of confusion between his AMERICAN INTELLIWARE Marks ("AMERICAN INTELLIWARE" which mark Applicant has found no state or federal registrations under the name of Opposer and AI AMERICAN INTELLIWARE AND DESIGN which mark Applicant has found that Opposer has no valuable property rights) and Applicant's INTELLIWEAR mark. (Notice of Opposition §§8-9) The undisputed facts establish, however, that there is no likelihood of confusion and that Applicant is entitled to a judgment as a matter of law. Accordingly, Applicant's Motion for Summary Judgment should be granted, dismissing TANNEN's opposition in its entirety.

1. Likelihood of Confusion is a Question of Law, Properly Resolved on Motion for Summary Judgment.

In pertinent part, 15 U.S.C. §1052(d) bars registration of a trademark that "consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the Untied States by another and not abandoned, as to be likely, when used on or in connection with applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . ." TANNEN alleges that Applicant's mark INTELLIWEAR will damage Opposer within the meaning of this Section and Section 1052(a). (Notice of Opposition §9).

The existence of a likelihood of confusion between trademarks is a question of law, to be determined by evaluating and balancing the following pertinent evidentiary factors enunciated in the *Du Pont* case (*In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973):

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

3. The similarity or dissimilarity of established, likely-to-continue trade channels.

4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.

5. The fame of the prior mark (sales, advertising, length of use).

6. The number and nature of similar marks in use on similar goods.

7. The nature and extent of any actual confusion.

8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

10. The market interface between applicant and the owner of a prior mark:

a. a mere "consent" to register or use.

b. agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.

c. assignment of mark, application, registration and good will of the related business.

d. laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

11. The extent to which applicant has a right to exclude others from use of its mark on its goods.

12. The extent of potential confusion, i.e., whether *de minimis* or substantial.

13. Any other established fact probative of the effect of use.

The Federal Circuit and this Board frequently have held that not every factor is equally important to the likelihood of confusion analysis in every case, and that a single *Du Pont* factor may be dispositive of the issue. *See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards,* 148 F.3d 1373, 1374-75 (Fed. Cir. 1998). Here, the dissimilarity of the competing marks is dispositive and therefore a sufficient basis for entry of summary judgment dismissing the opposition in its entirety. *See, e.g., id.* (affirming Board's treatment of dissimilarity alone precluded any reasonable likelihood of confusion); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d at 332-33 (dissimilarity between the marks "fully supports" entry of summary judgment dismissing an opposition); *Mattel, Inc.*, 1997 TTAB LEXIS 148, *6 (dissimilarity of the marks under the first *Du Pont* factor held dispositive on summary judgment).

2. There is No Likelihood of Confusion Because the Competing Marks are Dissimilar In Their Entireties as to Appearance, Sound, Connotation and Commercial Impression.

Applicant's INTELLIWEAR mark and any of the AMERICAN INTELLIWARE Marks are so undisputedly dissimilar that even the two Examining Attorneys of the USPTO who were assigned to review application of Applicant did not find AI AMERICAN INTELLIWARE AND DESIGN confusingly similar to INTELLIWEAR.

The first factor in *Du Pont* is "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impressions." *See In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). "[S]imilarity is determined on the basis of the total effect of the designation, rather than a comparison of individual features." *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981) (citations omitted). *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (CCPA 1974) (the Board may not dissect competing marks to determine confusing similarity but must consider the similarities of the marks taken as a whole).

Considered in its entirety, Applicant's INTELLIWEAR mark is therefore readily distinguishable from any of the AMERICAN INTELLIWARE Marks. The only similarity between the marks is that the marks have the first seven letters INTELLI. The similarity of these letters is entirely insufficient to support a finding of a likelihood of confusion.[1] *See id.* (no likelihood of confusion between ALPHA and ALPA marks in view of the total effect of the marks); *Industrial Nucleonics Corp. v. Edward J. Hinde, d.b.a. Hinde Engineering Co.*, 475 F.2d 1197, 1199 (CCPA 1973) (agreeing with the Board's consideration of the marks in their entireties and its conclusion that visual inspection and vocalization of ACCURA-FLO and ACCURAY marks "bring out substantial differences in sound, appearance, connotation, and commercial impression'"); *Lever Brothers Co. v. The Barcolene Co.*, 463 F.2d 1107, 1108-09 (CCPA 1971) (agreeing with the Board's consideration of marks in their entireties and its conclusion of no likelihood of confusion between

[1]Furthermore, when the question of likelihood of confusion involves an applicant's mark and an opposer's "family of marks," the opposer must show that the designation constituting the familiar element is recognized by the public as indicative of a common origin of the goods. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462-63 (Fed. Cir. 1991). To the extent that TANNEN relies upon the "family of marks" doctrine, he cannot claim that the letters "INTELLI" constitute the common element recognized by the public.

ALL and ALLCLEAR marks); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402 (CCPA 1970) (agreeing with the Board that the mere presence of the word "peak" in the mark PEAK PERIOD does not, standing alone, create a likelihood of confusion and that, considered in their entireties, the marks PEAK and PEAK PERIOD neither look nor sound alike); *Sears Mortgage Corp. v. Northeast Savings F.A.*, 1992 TTAB LEXIS 46, *9-10, 24 USPQ2d 1227 (TTAB 1992) (considered in their entireties, APPROVAL PLUS and APPROVALFIRST marks held to be sufficiently different in appearance, pronunciation, and meaning as to preclude finding of likelihood of confusion, even as used with identical services); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 1992 TTAB LEXIS 4, *11, 23 USPQ2d 1460 (TTAB 1992) (no likelihood of confusion between applicant's EDSA mark for computer programs for electrical distribution system analysis and design and opposer's EDS mark for computer data processing programming/information management services); *The Reynolds and Reynolds Co. v. I.E. Systems, Inc.*, 1987 TTAB LEXIS 6, *7, 5 USQP2d 1749 (TTAB 1987) (no likelihood of confusion between applicant's ACCULINK and opposer's ACCU-prefixed marks); *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986) (POLY PRO and POLY FLO marks not confusingly similar). *See also Keebler Co. v. Murray Bakery Products,* 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (no triable issue of fact that PECAN SHORTEES for pecan cookies would be likely to cause confusion with PECAN SANDIES for pecan cookies); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 332-33, 21 USPQ2d 1142 (Fed. Cir. 1991) (applicant's mark FROOTIE ICE too dissimilar to opposer's FROOT LOOPS mark to be likely to cause confusion, even though the goods with which the marks were used were related).

The mere sharing of the prefix INTELLI is wholly insufficient to create a likelihood of confusion between the Applicant's INTELLIWEAR mark and the AMERICAN INTELLIWARE Marks in view of the fact that the AMERICAN INTELLIWARE Marks, when viewed and vocalized in their entireties, appear longer and sound completely different. Moreover, the prefix INTELLI is common in the computer field and cannot be distinctive to the Opposer. A search of the USPTO online database using the search term INTELLI? to capture any active mark which has INTELLI as the first seven letter or prefix of any word in the mark revealed the prefix INTELLI is a crowded market in International Class 9 (**Exhibit C**). The search was narrowed down to "computer" (**Exhibit D**) and the search revealed 622 references with 280 registrations which include the letters INTELLI as part of the marks in the computer field. As such, when taken in their entire contexts, Applicant's INTELLIWEAR mark and AMERICAN INTELLIWARE Marks are not confusingly similar and Opposer cannot therefore base any similarity between his pleaded marks and the mark of Applicant on the letters INTELLI. Applicant further contends that as a result of these searches revealing a large number of registrations of marks containing the INTELLI prefix, AMERICAN INTELLIWARE Marks are not strong marks and not subject to a broad range of protection.

Further enhancing the dissimilarity between Applicant's mark and the AMERICAN INTELLIWARE Marks is the term following INTELLI. Applicant's INTELLI**WEAR** mark for "wearable computer hardware and computer software, namely, wearable micro processor-powered computers and associated software used for hands free data entry, data storage, data retrieval and data processing, and used for electronic messaging and for connecting to the internet" suggests a product to be worn (clothing or garment). On the other hand, AMERICAN INTELLI**WARE** Marks

covering "computer software programs and user manuals sold as a unit" suggest items of the same material or type, such as tableware, earthenware, silverware, etc. Although the competing marks have in common the first seven letters INTELLI, they are certainly different in appearance and therefore create a different commercial impression. In fact, the marks are no more similar than EXPRESS to X*PRESS (*Information Resources, Inc. v. X*Press Information Services*, 1988 TTAB LEXIS 74; 6 U.S.P.Q.2D (BNA) 1034); CROSS-OVER to CROSSOVER (*Sears, Roebuck and Co.*, 1987 TTAB LEXIS 84; 2 U.S.P.Q.2D (BNA); PLAYERS for men's underwear to PLAYERS for shoes (*British Bulldog, Ltd.*, 1984 TTAB LEXIS 15; 224 U.S.P.Q. (BNA) 854); BOTTOMS UP for ladies' and children's underwear to BOTTOMS UP for men's clothing (*Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977), or ASTRA for computerized blood analyzer and ASTRA for pharmaceutical preparations and syringes (*Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201; 1983 U.S. App. LEXIS 15956; 220 U.S.P.Q. (BNA) 786).

3. There is No Likelihood of Confusion Because Applicant's INTELLIWEAR Mark and Opposer's Marks are Used Respectively with Distinct Goods.

Opposer states that goods to which Applicant's alleged INTELLIWEAR mark will be applied and the goods upon which his AMERICAN INTELLIWARE Marks are extensively used and/or registered are or are likely to be related. Such analysis of Opposer fails to recognize the issue of distinctiveness of goods involved under his marks and that of Applicant's mark. The computer software industry is so vast that there are almost an infinite number of specialties and disciplines. Computer software programs are developed every day to meet the demand of computer use not only in all aspects of today's business but also for personal use. The goods under Applicant's mark are

completely unrelated to the goods covered by Opposer's marks. Although the marks are facially "related" to computer software, the functions of the goods are quite distinct so that no likelihood of confusion is possible.

Applicant's INTELLIWEAR mark covers wearable computer hardware and computer software, namely, wearable micro processor-powered computers and associated software used for hands free data entry, data storage, data retrieval and data processing, and used for electronic messaging and for connecting to the internet. Typical users of Applicant's goods are individuals who do not want to be encumbered by big and heavy computer equipment but want mobility and action at the same time.

On the other hand, since Opposer did not state in his Notice of Opposition the function of the computer software programs that he claims he has and been using his marks on, Applicant searched the USPTO online database and the Internet to find about the computer software programs produced by the suspended registrant, American Intelliware Corporation. (See **Exhibits E and F**). Based on these searches, Applicant believes that the computer software programs supposedly offered under the AMERICAN INTELLIWARE Marks are entirely different from that of Applicant's products.

Although both marks deal with computer software, the TTAB has held that "there must be some similarity between the goods beyond the fact that each involves the use of computers." *See Reynolds and Reynolds Co. v. I.E. Systems, Inc.*, 1987 TTAB LEXIS 6, *; 5 U.S.P.Q.2D (BNA) 1749. The original trademark application from American Intelliware Corporation was requested for "Computer Software Systems." This identification of goods definition was rejected by the examiner

as "too indefinite for registration purposes."[2] The identification of goods for the mark was amended to "Computer software programs and user manuals sold as a unit,"[3] which narrows even further, the scope of goods that the putative owner of the mark AI AMERICAN INTELLIWARE AND DESIGN could reasonably claim for purposes of claiming confusion.

That Opposer uses his marks in connection with computer programs and software does not allow him to pre-empt the entire field of computer program and computer software products, "especially as to other goods in that field that are totally dissimilar to its products." *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1208 (1st Cir. 1983). Moreover, use in the same broad field is insufficient to create a triable issue of fact on the question of likelihood of confusion. *See id.* at 1210 (affirming grant of summary judgment of no infringement, holding that use in the same broad field "is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion"). Indeed, the Board has unequivocally rejected the argument that the parties' products are so related as to create a likelihood of confusion simply because the products are computer software. In the *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 1992 TTAB LEXIS 4, 23 U.S.P.Q.2d (BNA) 1460 case, the Board stated as follows:

> Opposer argues that the parties' products are related because each party provides software programs which process data. We decline to interpret the concept of related goods so broadly. All computer software programs process data, but it does not necessarily follow that all computer programs are related. Given the ubiquitous use of computers in all aspects of business in the United States today, this Board and its reviewing Court have rejected the view that a relationship exists between goods and services simply because each involves the use of computers. *See Octocom Systems, Inc. v. Houston*

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[2] File Wrapper for the mark AI AMERICAN INTELLIWARE AND DESIGN, Registration No. 1,347429; USPTO Office Action No. 1.

[3] File Wrapper for the mark AI AMERICAN INTELLIWARE AND DESIGN, Registration No. 1,347429; USPTO Office Action No. 2.

> *Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Information Resources, Inc. v. X*Press Information Services, 6 USPQ2d 1034 (TTAB 1988). *In particular, the fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under the same marks. See Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 USPQ2d 1749, 1751 (ttab 1987).

(EDSA for computer-aided manufacturing and design software and EDS for data processing and information management software are not confusingly similar where the goods themselves and the relevant consumers are different).

4. **The Relevant Consuming Public is Not Likely to Confuse Applicant's INTELLIWEAR Mark with Opposer's Marks.**

Opposer claims that Applicant's INTELLIWEAR mark falsely suggests connection with Opposer and constitutes a false representation that Applicant's goods are approved or sponsored by Opposer. Applicant contends that likelihood of confusion as to the source of origin of respective products is not possible as purchasers of computer hardware and computer software programs are sophisticated consumers. Since the goods sold under these marks are specialty items, performing specialized and different functions, the purchasers are highly discriminating consumers to know the nature, function and maker of the respective goods. Buying computer software program is especially not an impulse reaction. Buyers of computer software programs are capable of distinguishing the goods at issue. *See Kinark Corp. v. Camelot, Inc.*, 548 F. Supp. 429; 1982 U.S. Dist. LEXIS 15024 (no likelihood of confusion found between two CAMELOT marks for hotel services, in part because the purchasers of such services are careful buyers capable of inquiring into and understanding information about the sources of services, despite the similar trade channels). *See also Beneficial Corporation, Beneficial Management Corporation of America and Beneficial Finance Co. of New*

York, Inc., v. Beneficial Capital Corporation and Beneficial Capital Management Corporation, 529 F. Supp. 445; 1982 U.S. Dist. LEXIS 10337; 213 U.S.P.Q. (BNA) 1091.

Significantly in *Beneficial*, the Court noted that, although the parties' respective services are both "loan" services, they "appeal to different customers, are sold in entirely different markets, exist for distinct purposes, and thus, are in no sense proximate products." Moreover, the Court explicitly rejected the plaintiff's contention that likelihood of confusion among the general public was relevant, noting that the prospective customers of the parties are the relevant class of purchasers, not the general public.

The principles applicable to the *Camelot* and *Beneficial* cases are equally applicable to the Applicant's issue and serve to distinguish the parties' marks, particularly since the marks in those cases were so similar. Even where the marks themselves are similar, the dissimilarity of the parties' goods and/or services and the degree of care with which they are purchased can preclude a likelihood of confusion. (*See British Bulldog, Ltd.*, 1984 TTAB LEXIS 15; 224 U.S.P.Q. (BNA) 854; *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201; 1983 U.S. App. LEXIS 15956; 220 U.S.P.Q. (BNA) 786).)

There is a difference in the target markets, because of the difference in the goods offered under these two marks. The Applicant's goods are sold to individuals who want portability and mobility. On the other hand, a typical purchaser of Opposer's goods, based on the limited information about the goods offered by Opposer and on the description of goods in others marks registered under the suspended American Intelliware Corporation, are prospective story writers, screen writers or other people who would like to get involved in writing or publication or the film industry. As such, the purchasers and users of Applicant's goods and those of Opposer are separate,

distinct individuals. In this respect, this case is analogous to *Information Resources Inc. v. X*Press Information Services.* In *Information Resources, Inc. v. X*Press Information Services*, the TTAB, while it recognized that there may be an overlap in the ultimate end users of applicant's goods and opposer's services, that both require the use of a computer, and that both may be used to access computer data, it also recognized that the goods and services themselves are distinct, that the marks differ significantly in appearance, and that the goods and services involved in the case are relatively expensive and are not purchased on impulse. Here, the only overlap results from the fact that Applicant's goods and registrant's goods are, to an extent, software, that, however is where the similarities end.

The goods of Applicant's and those of Opposer's are certainly not impulse purchases. Prospective purchasers of Applicant's products first request and receive an actual presentation and demonstration of the products, hence, there is no possible confusion as to source of origin of the products. (See *Kinark Corporation v. Camelot, Inc.; Beneficial Corporation v. Beneficial Capital Corporation* - The question of the proximity of the products is considered in connection with the question of the sophistication of the buyers because of the closeness of two products is, at least in part, a function of the extent to which purchasers can and do examine and distinguish them.]

Applicant's goods are specifically different from and non-competitive with the Opposer's goods. (See *Electronic Design & Sales, Inc., v. Electronic Data Systems Corp.*, 954 F.2d 713, 716-17 (Fed. Cir. 1992); *Astra Pharmaceutical Products, Inc.*, 718 F.2d at 1206 - If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e., a likely customer or purchaser.)

5. **The Opposer's Marks are Not Famous to Establish Likelihood of Confusion.**

Opposer claims that he has used his marks since as early as June 15, 1984 and has therefore acquired substantial consumer recognition. Applicant contends the opposite as Applicant's search of the Internet for AMERICAN INTELLIWARE revealed only 4 hits at most. **Exhibits H thru J.** Since no mention of AMERICAN INTELLIWARE as a product name on Opposer's computer software products is available through the most popular source of reference by consumers the Internet, Opposer's AMERICAN INTELLIWARE Marks cannot be considered famous despite his claim of continuous use since as early as June 15, 1984.

6. **Opposer Has No Valuable Property Rights - The Mark AI AMERICAN INTELLIWARE Has Been Abandoned**

As indicated above, the mark AI AMERICAN INTELLIWARE was owned by the American Intelliware Corporation at the time its corporate powers were suspended and it ceased to exist as a legal entity as of June 4, 1994. Almost eight years have passed since the owner of the mark passed into oblivion, and took with it, any use of the mark. Three years of nonuse is prima facie evidence of abandonment:

> A mark shall be deemed 'abandoned' . . . (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark. 15 USCS § 1127.

Opposer has claimed throughout his Notice of Opposition rights by and because of his alleged possession of the mark AI AMERICAN INTELLIWARE, with a priority date based on the original registration to American Intelliware Corporation, a California Corporation. As has been demonstrated by the public records of the USPTO and the California Secretary of State, that claim

is void. In addition, Opposer has not put forth any allegations that would support any claim independent of the mark's registration or common law claim over the mark. In fact, in another proceeding filed against the Opposer and his claimed mark[4], the Opposer submitted copies of computer disk labels that all appear to be from the 1980's, during which time the corporate owner was still a legal entity. Based on the nature of the alleged "trademark assignment" claimed by Opposer, and this thin evidence provided in response to a cancellation proceeding, it appears that no one has used the mark in any manner at least since the suspension of the American Intelliware Corporation on June 1, 1994, now almost eight years ago.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that its Motion for Dismissal for lack of subject matter jurisdiction for want of standing by the Opposer be granted. In the alternative, because the undisputed facts establish the dissimilarity between the Applicant's INTELLIWEAR mark and Opposer's AMERICAN INTELLIWARE Marks, thereby precluding a finding of likelihood of confusion, and because no facts beyond those available in connection with this Motion can reasonably be expected to change that result, Applicant respectfully requests that his Motion for Summary Judgment be granted

Respectfully submitted,

Date: April 26, 2002

Robert T. Daunt, Esq.
Mark W. Good, Esq.
DAVIS & SCHROEDER,
A PROFESSIONAL CORPORATION
215 West Franklin, 4th Floor

[4] Cancellation No. 31660, Intelliware Systems, Inc. v. Mark D. Tannen

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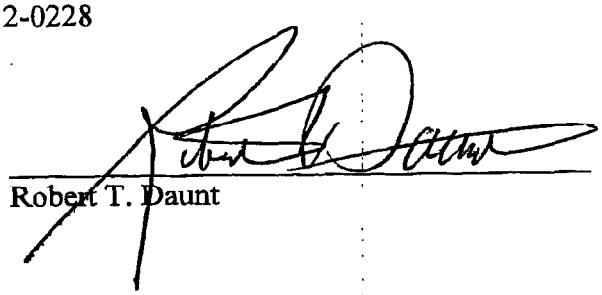
Attorneys for Applicant,
JAY MACK

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION was mailed FIRST CLASS mail, postage prepaid, this 26th day of April, 2002 on Opposer's counsel:

Paul J. Reilly, Esq.
BAKER BOTTS, L.L.P.
101 Rockefeller Plaza, 44th Floor
New York, NY 10112-0228



Robert T. Daunt

State of California

SECRETARY OF STATE

DOMESTIC CORPORATION
CERTIFICATE OF FILING AND SUSPENSION

I, BILL JONES, Secretary of State of the State of California, hereby certify:

That on **November 23, 1983, AMERICAN INTELLIWARE CORPORATION,** corporate number **C1217163,** became incorporated under the laws of the State of California by filing its Articles of Incorporation in this office.

That on **June 1, 1994,** pursuant to the provisions of the California Bank and Corporation Tax Law, more particularly Section 23302 of the Revenue and Taxation Code, the Franchise Tax Board transmitted a list to this office containing the names of domestic corporations, the exercise of whose corporate powers, rights and privileges had been suspended under that law, which included the above-named corporation.

That the corporate powers, rights and privileges of the above-named corporation remain suspended, reinstatement never having been effected.

IN WITNESS WHEREOF, I execute this certificate and affix the Great Seal of the State of California this day of December 19, 2001.

S
of State

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EXHIBIT A

LAW OFFICES
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FACSIMILE COVER SHEET

This transmission totals **80** pages including Cover Sheet.

To: Duane Bowling	**From: Mark Good**
Company: USPTO	**Date: July 18, 2002**
Fax No.: (703) 308-9333	**Client Name/No.:**
Phone No.: (703) 308-9300 x-171	**Operator: Angela**

RE: Memorandum of Law in Support of Applicant's Motion to Dismiss Opposition for Lack of Subject Matter Jurisdiction, or in the Alternative for Summary Judgment (FRCP 12(B)(1), FRCP 56(C);Applicant's Motion for Summary Judgment; Letter to TTAB Requesting Correction in Street Address of Opposing Counsel and Renumbering of Certain Exhibits

Mr. Bowling

Per your request attached is a copy of our brief that was lost. Opposition No. 91151109 Serial No. 75/845,350 Mark D. Tannen v. Jay Mack. If you have any questions or do not receive all the pages please give us a call.

Thank you,
Angela Ramirez,
Assistant to Mark Good

ORIGINAL ~~WILL~~/WILL NOT FOLLOW

	Pls. Review and call to discuss your comments		For your appropriate action
	Pls. Review and return with your comments	✔	For your information and file

IMPORTANT NOTICE